

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: Venegas, Jr.

Serial No.: 10/027,954

Group No.: 3635

Filed: December 19, 2001

Examiner: N. Slack

For: ENTRANCE BARRICADE FOR VEHICLES USING LOADING DOCKS, AND THE LIKE

APPELLANT'S APPEAL BRIEF

Mail Stop Appeal Brief

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

04/30/2004 SDIRETA1 00000033 10027954
01 FC:2402

165.00 OP

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 5 claims. Claim 5 has been canceled; accordingly, claims 1-4 remain pending, and are under appeal.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

An after-final amendment is enclosed herewith for the consideration of the Examiner.

V. Concise Summary of the Invention

This invention improves upon the existing art by providing a sturdy, very low maintenance

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barrier defining width and height dimensions for use by vehicles such as semi-trucks, and the like, on loading docks (Specification, page 3, lines 6-8). In broad and general terms, the invention includes a pair of parallel vertical side members defining an entrance with, and an upper horizontal member connected therebetween, defining a vertical extent (Specification, page 3, lines 8-10). The various members are preferably comprised of rigid metallic pipes covered by resilient polymeric material (Specification, page 3, lines 10-12). The preferred embodiment of the invention includes a pair of vertical side members onto which there is installed a horizontal member having a length that extends beyond the outermost extent of the side members (Specification, page 3, lines 13-15). In an alternative embodiment, the vertical members extend vertically higher than the vertical extent of the horizontal member (Specification, page 3, lines 15-17). In a further alternative embodiment, the height may be adjusted or the area defined by the vertical and horizontal members entirely restricted to vehicle traffic, preferably through the use of multiple horizontal members spanning the vertical members (Specification, page 3, lines 17-20).

VI. Concise Statement of Issues Presented For Review

1. Was claim 1 properly rejected under 35 U.S.C. §112, first paragraph?
2. Are claims 1, 2 and 4 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,261,647 to Venegas, Jr. in view of U.S. Patent No. 5,370,368 to Terrels et al.?
3. Is claim 3 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,261,647 to Venegas, Jr. in view of U.S. Patent No. 5,370,368 to Terrels et al. as applied to claim 1, and further in view of U.S. Patent No. 5,354,037 to Venegas, Jr.?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

Appellant believes the following groups of claims represent patentably distinct inventions which should be given independent consideration on appeal:

Group I: Claims 1, 2 and 4; wherein claims 2 and 4 stand or fall with claim 1; and

Group II: Claim 3.

VIII. Argument

A. Claim 1 is Allowable Under 35 USC §112, First Paragraph

The Examiner contends that claim 1 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, a "saddle weld" is not disclosed in the specification. Appellant respectfully disagrees. First, saddle welds are notoriously well known to anyone of skill in the art to which this invention pertains, and a typical saddle weld is shown at least in Figure 3 of the instant specification. Secondly, in rejecting claims 1, 2 and 4 under 35 U.S.C. §103(a), the Examiner contends that U.S. Patent No. 5,370,368 to Terrels et al. is applicable, because "Terrels et al. shows a composite plastic and handrail assembly and discloses that the horizontal and vertical rails can be connected by saddle welding (column 2, lines 60-63) ...". How is it, that the Examiner understands full well what is meant by saddle welding from a piece of prior art, but when the application that he is examining uses such terminology, it can be non-enabling? The fact is, the rejection under 35 U.S.C. §112, first paragraph should be withdrawn.

B. Group I - Claims 1, 2 and 4; wherein claims 2 and 4 stand or fall with claim 1

Claims 1, 2 and 4 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,261,647 to Venegas, Jr. et al. in view of U.S. Patent No. 5,370,368 to Terrels et al. The Examiner contends that it would have been obvious to combine these two references "to improve the outward appearance and strength of the guard rail ... with the strength of steel and energy absorbing, low maintenance benefits of plastic ...". This conclusion is misguided on several grounds. First, Terrels et al. does not teach or suggest a "saddle weld," at least not a saddle weld between metal components. Rather, referring to the section of Terrels et al. referenced by the Examiner, "a simple butt joint may be used where a skilled operator is available to heat-weld the abutted plastic pipe end to form a seamless connection. (Column 2, lines 60-63.) Using other passages cited by the Examiner, the *only* motivation of Terrels et al. to use a butt-joint, is to improve the appearance. Nowhere in Terrels et al. is any mention made of strength and, in fact, a metal-to-metal weld is precluded due to the fact that in all instances, plastic heats plastic. It is well-settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine

references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, the Examiner concedes that the Venegas reference is silent as to positive limitations of the invention, including saddle welding of the metal joint, and there is no teaching or suggestion whatsoever in Terrels et al. to use the system set forth in the Venegas, Jr. reference. Accordingly, *prima facie* obviousness has not been established.

C. Group II - Claim 3

Claim 1 includes the limitation of vertical side members which have a length that extends beyond the upper extent of the horizontal member. The Examiner concedes that the Venegas reference does not show vertical side members having a length that extends beyond the upper extent of the horizontal member and contends that in view of U.S. Patent No. 5,354,037, such a configuration would be obvious. Again, there is no teaching or suggestion *from the prior art* in support of the Examiner's argument. The Examiner states that it would have been obvious "to modify" the guard rail of Venegas ... to simulate the appearance of post and rail, a popular fencing style." However, there is no evidence whatsoever, from the prior art, or from the record, as to any motivation "to simulate the appearance of a post and rail," or any indication whatsoever that "a popular fencing style" is a goal. Accordingly, again, *prima facie* obviousness has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

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Date: April 26, 2004

Respectfully submitted,

By: _____

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APPENDIX A**CLAIMS ON APPEAL**

1. A barrier defining a width and height for vehicles as might be found on a loading dock, comprising:

a pair of vertical side members, each composed of metallic elements covered by a polymeric sheathing;

a horizontal member, also comprised of a metallic element covered by polymeric sheathing, spanning the two vertical members,

the horizontal member defining a height distance with respect to the loading platform into which the vertical members are received; and

wherein the vertical side members and the horizontal member are attached by way of a saddle weld.

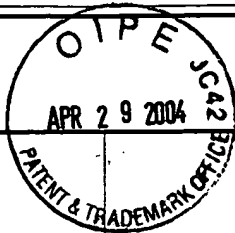
2. The barrier of claim 1, wherein the horizontal member has a length which extends beyond the outermost extent of the vertical side members.

3. The barrier of claim 1, wherein the vertical side members have a length which extends beyond the upper extent of the horizontal member.

4. The barrier of claim 1, wherein the vertical side members and the horizontal member are attached by way of a removable fastener.

TRANSMITTAL OF APPEAL BRIEF (Small Entity)Docket No.
IDS-14602/14

In Re Application Of: Venegas, Jr.

Serial No.
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Dec. 19, 2001Examiner
N. SlackGroup Art Unit
3635

Invention: ENTRANCE BARRICADE FOR VEHICLES USING LOADING DOCKS, AND THE LIKE

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
February 27, 2004

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☐ has already been filed in this application.

The fee for filing this Appeal Brief is: **\$165.00**

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **07-1180**


SignatureDated: April 27, 2004

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